

### **REMARKS/ARGUMENTS**

Claims 1-30 are pending in the captioned application. Claims 23, 24, 26 and 27 have been cancelled. Applicants hereby amend claims 1, 6 and 12-14 and cancel claims 4-5, 7, 9-11, 20-21 and 29-30. Applicants have also added new claims 31-36. Applicants submit that the claim amendments are fairly based on the specification and do not add new matter. Applicants request reconsideration and allowance of claims 1-3, 6, 8, 12-19, 22, 25, 28 and 31-36.

Claims 1 and 14 are amended such that the cDNA:RNA heteroduplex is used directly in the self-ligation reaction, to form circular cDNA. Support for this amendment is in the paragraph bridging pages 3 and 4, as well as in Figure 5. The current claims are amended such that the rolling circle amplification is performed using nuclease resistant primers. Support for the use of nuclease resistant primers can be found on page 7, lines 1-18 of the specification. Claims 31-36 are added. These claims are similar in scope to the now cancelled claims 4, 10 and 20. Support for the new claims can be found in Figures 1-4, as well as page 3, lines 7-14. Other amendments to the claims are made to correct minor informalities.

The pending claims stand rejected under 35 U.S.C. §102(e) as being anticipated by Kumar et al. (US 6,977,153). Applicants respectfully disagree.

Applicants first submit that the amended claims are not anticipated by Kumar. Kumar does not teach the self-ligation of cDNA without removing the RNA from the

cDNA:RNA duplex (claims 1 and 14) nor does Kumar teach blunt-end ligation of double-stranded cDNA (claims 31 and 36). All the other claims depend on one of these claims and therefore could not have been anticipated by Kumar.

In addition, Applicants submit that Kumar does not claim the same invention. Should the Examiner still find that certain aspects of the claimed invention are disclosed in Kumar, Applicants respectfully request reconsideration of Applicants' declaration filed on 11/21/2006, which clearly established a priority of invention. Applicants respectfully submit that the rejection of the claims by Kumar should now be withdrawn.

Claims 1-5 and 14-21 stand rejected under 35 U.S.C. §102(e) as being anticipated by Beach et al. (US 2003/0082559). Applicants respectfully disagree.

Applicants submit that Beach et al. does not teach or even suggest the claimed invention. In particular, Beach et al. does not teach or suggest self-ligation of cDNA without removing the RNA from the cDNA:RNA duplex (claims 1 and 14) nor does Beach et al. teach blunt-end ligation of double-stranded cDNA (claims 31 and 36). All the other claims depend on one of these claims and therefore could not have been anticipated by Beach et al. Applicants submit that the 35 U.S.C. §102(e) rejection of the claims over Beach et al. should be withdrawn.

Claims 6-13, 22, 25 and 28-30 stand rejected under 35 U.S.C. §103 (a) as being unpatentable over Beach et al. in view of Cleuziat et al. (US 5,849,547). Applicants respectfully disagree. In response, Applicants submit that as discussed above, Beach et al. does not teach or suggest certain features of the claimed invention, therefore does not

anticipate the independent claims. As such, Applicants submit that combining Beach with Cleuziat would not render claims 6-13, 22, 25, and 28 obvious.

Claims 1-5 and 14-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fischer (US 5,876,932) in view of Lizardi (US 5,854,033). Applicants respectfully disagree.

Applicants submit that neither Fischer nor Lizardi teach or suggest an amplification method that include a self-ligation step of reverse transcribed cDNA, as claimed in the pending claims (self-ligation of cDNA directly from a cDNA:RNA duplex, or from a blunt-end, double-stranded cDNA). Applicants submit that the combination of the references do nothing to remedy this defect, and therefore can not render obvious the claimed invention.

Claims 14-17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Connor et al. (US 2002/0004592) in view of Lizardi (US 5,854,033). Applicants respectfully disagree.


Applicants submit that neither Connor nor Lizardi teach or suggest an amplification method that include a self-ligation step of reverse transcribed cDNA, as claimed in the pending claims (self-ligation of cDNA directly from a cDNA:RNA duplex, or from a blunt-end, double-stranded cDNA). Applicants submit that the combination of the reference does nothing to remedy this defect and therefore can not render obvious the claimed invention.

Claims 29 and 30 have been cancelled therefore any objection/rejection for these claims are now moot.

Applicants believe that the above constitutes a complete response to the outstanding Office action and claims 1-3, 6, 8, 12-19, 22, 25, 28 and 31-36 are now in allowable form. Early and favorable action is earnestly solicited.

Respectfully submitted,

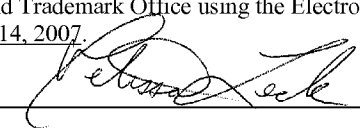
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